

## REMARKS

### I. STATUS OF THE CLAIMS

Claims 4, 5, 7, 8, 9 and 18 have been amended. Claims 2-5, 7-9 and 18 are pending and under consideration. Applicants assert that no new matter has been added. Support for this amendment can be found, for example, in the Specification pg. 26, lines 27-30 and pg. 27 lines 11-16.

### II. ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116

Applicants request entry of this Rule 116 Response and Request for Reconsideration because applicant's response does not significantly alter the scope of the claims and places the application at least into a better form for appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (emphasis added). Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### III. REJECTION UNDER 35 U.S.C. § 103(a)

Claims 2-5, 7-9 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsukuda, (U.S. 6,085,170) in view of Handel et al. (U.S. 6,195,651), Jones et al. (U.S. 7,082,400) and Moreno et al. (U.S. 2002/0035515). This rejection is respectfully traversed.

Claim 5 recites:

a database registering user information including a home address and a working place address of the receiver, an address of each of a **plurality of convenience stores** for relaying the parcel, and consignment information about the parcel to be transmitted to the receiver

(emphasis added, claim 5, lines 3-5). On page 2, item 5(a), the Office Action relies on Tsukuda and states that "the examiner considers consignment relay stations to be a form of convenience stores, due to the fact that they are there for the consumer's convenience in accepting

deliveries.” Applicants respectfully traverse the Office Action’s assertion that “consignment relay stations” equate to “convenience stores” as recited in claims 5, 8 and 18. The Office Action’s rationale is based on the faulty premise that because the relay stations are merely “convenient,” they equate to “convenience stores.” All facilities that may be “convenient” are not necessarily “convenience stores.” A convenience store is defined as “a retail store that carries a limited selection of basic items, as packaged foods and drugstore items, and is open long hours for the convenience of shoppers.”<sup>1</sup> A mere consignment relay station would not be considered a “retail store.” Accordingly, the cited art does not describe “convenience stores” as recited in independent claims 5, 8 and 18.

In addition, claim 5 as amended recites:

...displaying an **advertisement and a privilege**, and receiving the information about the designated convenience store and the designated date and time...

...**providing a privilege to the receiver** when the receiver receives the parcel

(emphasis added, claim 5, lines 18-20). Applicants assert that the cited art does not describe the above-mentioned features.

On page 3, item 5(e), the Office Action considers a delivery notification as described in Tsukuda to be a form of “privilege.” A “delivery notification,” however, does not correspond to the “privilege” described in the embodiment of claim 5. In a non-limiting example, the embodiment shown in Figure 11 of the present application shows that a “privilege” is reserved for the user when the user obtains the parcel by the scheduled delivery time. In other words, the “privilege” is used as an incentive to obtain the parcel as scheduled. A mere “delivery notification” described in Tsukuda does not provide such an incentive.

Moreover, claim 5 has been amended to emphasize this feature and recites “displaying an advertisement and a privilege” (emphasis added). In a non-limiting example, Figures 11-13, 15 illustrate a “privilege” provided at the two different convenience stores. (see also, Specification pg. 26, lines 27-30). Tsukuda merely provides a delivery notification, and therefore, does not disclose such a feature.

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<sup>1</sup> convenience store. (n.d.). *Dictionary.com Unabridged (v 1.1)*. Retrieved September 06, 2007, from Dictionary.com website: [http://dictionary.reference.com/browse/convenience store](http://dictionary.reference.com/browse/convenience+store)

Applicants submit that Handel, Jones, and Moreno, individually or combined, fail to cure the deficiencies of Tsukuda described above. Accordingly, claim 5 patentably distinguishes over the cited art for at least the above-mentioned reasons.

Independent claim 8 recites:

registering consignment information in a database of a home-delivery server including an address of each of a plurality of convenience stores...  
displaying an advertisement and a privilege about the convenience store...  
providing a privilege to the receiver when the receiver receives the parcel

(claim 8, lines 5-6 and 21-24). Therefore, claim 8 patentably distinguishes over the cited art.

Independent claim 18 recites

registering information, including addresses of each of a plurality of convenience stores...  
displaying an advertisement and a privilege about the convenience store...  
providing a privilege to the receiver when the parcel is delivered

(claim 18, lines 3-4 and 19-23). Therefore, claim 18 patentably distinguishes over the cited art.

Dependent claims 2-4, 7 and 9 inherit the patentable recitations of their respective base claims, and therefore, patentably distinguish over the cited art for at least the above-mentioned reasons in addition to the additional features recited therein.

Accordingly, applicants respectfully request the rejection under 35 U.S.C. § 103(a) be withdrawn.

#### **IV. INFORMATION DISCLOSURE STATEMENT**

In response to applicant's assertion that Japanese Patent 8-13916 as well as the Japanese Office Action No. 2000-272587 dated April 7, 2006 were previously submitted, the Examiner states that these references should be resubmitted in the form of another Information Disclosure Statement.

Accordingly, a Supplemental Information Disclosure Statement that supplements the Information Disclosure Statement filed on June 30, 2006 is enclosed herewith. The enclosed Supplemental Information Disclosure Statement includes an English language abstract of Japanese Patent 8-13916, and Japanese Office Action No. 2000-272587 with an English language translation. Applicants respectfully request consideration of these references.

**V. CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

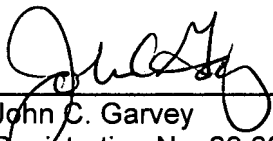
Respectfully submitted,

STAAS & HALSEY LLP

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10-5-07

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